

REMARKS

This amendment, submitted in response to the Office Action dated July 11, 2003, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

As an initial matter, Applicant submits that claims 1-8 are pending in the application. Claims 2-6 have been withdrawn from consideration. Therefore, Applicant requests that this error be noted.

Title

The Examiner has objected to the title for not being descriptive. Applicant proposes amending the title to read "ELECTROMAGNETIC DEVICE WITH COVER FOR PREVENTION OF DAMAGE TO CONDUCTOR OF ELECTROMAGNETIC DEVICE".

Drawings

Figs. 1, 3, and 4-8 have been amended as indicated in the proposed drawing corrections. Fig. 1 has been amended to include reference numeral 5, Fig. 3 has been amended to correct the thickness of the insulation in relation to the flash from the bobbin, Fig. 5 has been corrected to show reference numeral 50, Fig. 5 item "100" has been amended to read "101", and Figs. 4-8 have been designated as prior art. Applicant respectfully requests approval of the proposed drawing corrections.

Rejection of claim 1 under §102(b) as being anticipated by Shibuta

The Examiner maintains Shibuta discloses an electromagnetic device body including a coil formed with a conductor 2 wound around a bobbin 1 and a cover member enclosing said coil 4 and a cover for covering the electromagnetic device body 3. However, the Examiner has failed to establish “wherein said cover member protects said coil from being directly subjected to molding pressure when said cover is formed by injection molding, by covering said coil” as further described in claim 1. Since the Examiner has failed to establish all of the elements of claim 1, which is required to support an anticipation rejection, any subsequent Office Action should be made on a non-final basis.

Moreover, Shibuta does not disclose that epoxy based adhesive 4 which protects the oxide superconducting wire 2 from being directly subjected to molding pressure. In particular, the epoxy based adhesive 4 acts as a *filling resin* for *fixing* the superconducting wire 2 within the container. Column 1, lines 44-48. There is no indication throughout the reference that epoxy based adhesive 4 protects superconducting wire 2 from being directly subjected to molding pressure, and the Examiner has not indicated otherwise.

In addition, Shibuta does not disclose that container 3 is formed by injection molding. Container 3 is a stainless container. There is no indication in Shibuta as to how the stainless container 3 is formed and again, the Examiner has not established otherwise.

For the above reasons, claim 1 and dependent claim 8 should be deemed patentable.

Rejection of claims 7 and 8 under §103(a) as being unpatentable
over Shibuta in view of Ghorashi

The Examiner maintains that a combination of Shibuta and Ghorashi teaches the elements of claims 7 and 8.

Applicant submits that it is unlikely that one of ordinary skill in the art would combine Shibuta with Ghorashi. Ghorashi states that products prepared by melt coating a *resin* on magnet copper wire have often had deficiencies such as water crazing, marginal polymer flexibility, and poor stability at high temperatures. Column 1, lines 8-13.

Although this aspect of the invention was not cited by the Examiner, the Examiner must look at the references in their entirety. MPEP 2145. The references must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. *Akzo N.V. v. U.S. International*, 808 F.2d 1471, 1481 (Fed. Cir. 1986). Moreover, the Examiner cannot pick and choose among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention. *Id.* Therefore, since Ghorashi teaches away from the use of resin, whereas Shibuta teaches the use of resin, there would be no reason why one of ordinary skill in the art would combine the references.

The Examiner also maintains that Ghorashi teaches a conductor wire coated with an insulative material having a thickness of .04 mm. However, it is unclear where this is disclosed in the reference therefore, Applicant respectfully requests that the Examiner clarify where this is disclosed.

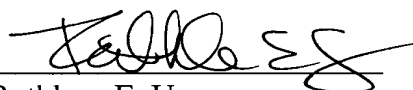
For the above reasons, claims 7 and 8 should be deemed patentable.

Applicant has also added claims 9-17 to provide a more varied scope of protection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: October 14, 2003 (*October 11, 2003 being a Saturday and
October 13, 2003 being Columbus Day*)